



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------------|-----------------------------|
| 10/524,457 | 02/10/2005 | Patrice Bujard | HC/12-22724/PCT | 8661 |
| 324 | 7590 | 10/16/2009 | | |
| JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591 | | | EXAMINER FISHER, ABIGAIL L | |
| | | | ART UNIT 1616 | PAPER NUMBER |
| | | | NOTIFICATION DATE 10/16/2009 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

andrea.dececchis@ciba.com
deborah.pinori@ciba.com
sonny.nkansa@basf.com

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/524,457 | Applicant(s) BUJARD ET AL. | |
| | Examiner ABIGAIL FISHER | Art Unit 1616 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 27 2009 has been entered.

Receipt of Amendments/Remarks filed on July 27 2009 is acknowledged. Claim 1 was amended. Claims 1-18 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 6-7, 9, and 11 recite the language "substantially consisting of". The transitional phrase "consisting of" excludes any element, step or ingredient not specified in the claim. **Note: MPEP 2111.02.** However, claims 1, 6-7, 9 and 11 recite substantially consisting of which indicate that some amount of other things can be

Art Unit: 1616

present. This contradicts the term consisting of. Therefore, the resulting claims are indefinite.

Claims 2-5, 8, 10 and 12-18 are included in the rejection as they depend on a rejected base claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 6-13 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bujard et al. (US 5,766,335, cited on PTO Form 1449).

Applicant Claims

The instant application claims a pigment comprising (a) a core consisting of SiO₂ with $0.95 < z < 2.0$ and (a2) at least one coating consisting of one or more silicone oxide, the molar ratio of oxygen to silicone being on average from 0.03 to 0.95.

Art Unit: 1616

The instant application claims a pigment comprising (a) a core consisting of a metallically reflecting material, and (b) at least one coating consisting of one or more silicon oxides, the molar ratio of oxygen to silicon being on average from 0.03 to 0.24.

The instant application claims a composition comprising a high molecular weight organic material and from 0.01 to 80% by weight based on the high molecular weight organic material of the above described pigment.

Determination of the scope and content of the prior art
(MPEP §2141.01)

Bujard et al. teach a colored luster pigments comprising a core consisting of a substantially transparent or metallic reflecting material and at least one coating consisting essentially of one of more silicon oxides having a molar ratio of oxygen to silicon being from 0.25 to 0.95 (col. 2, line 62 to col. 3, line 2). Column 3, lines 31-46 teach examples of the core material such as Si and Ti. Column 4, lines 8-9 teach that the pigments can further comprise an additional coating which is different from the first; lines 26-29 teach examples of the metal oxides and mixtures thereof that can be employed in the second coating; finally line 34-35 teach that the arrangement of coatings relative to the core may be in any order. Column 8, lines 28-30 teach that high molecular weight organic materials can be used with the pigments. When utilized they are used in amount from 0.1 to 30% by weight (column 9, lines 23-31). It is taught that the ratio of silicon to oxygen can be precisely controlled by adjusting the oxygen partial pressure (column 6, lines 57-65).

Ascertainment of the difference between the prior art and the claims
(MPEP §2141.02)

While Bujard et al. teach the same core and coatings, Bujard et al. do not exemplify the claimed pigments.

***Finding of Prima Facie Obviousness Rationale and Motivation
(MPEP §2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to manipulate the coating material and utilize a variety of different coating materials in varying order. One of ordinary skill in the art would have been motivated to vary the coating material and utilize different coating material in various order as Bujard et al. teach that the arrangement of the coatings relative to the core may be in any order.

Regarding the claimed molar ratio of oxygen to silicon, the examiner directs applicants' attention to **MPEP 2144.05**. "Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (Claimed process which was performed at a temperature between 40°C and 80°C and an acid concentration between 25% and 70% was held to be prima facie obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100°C and an acid concentration of 10%.); see also Peterson, 315 F.3d at 1330, 65 USPQ2d at 1382 ("The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a

Art Unit: 1616

disclosed set of percentage ranges is the optimum combination of percentages.”); In re Hoeschele, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969) (Claimed elastomeric polyurethanes which fell within the broad scope of the references were held to be unpatentable thereover because, among other reasons, there was no evidence of the criticality of the claimed ranges of molecular weight or molar proportions.). For more recent cases applying this principle, see Merck & Co. Inc. v. Biocraft Laboratories Inc., 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989); In re Kulling, 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990); and In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).” Based on the teachings of Bujard et al., one of ordinary skill in the art would know how to manipulate the oxygen and silicon ratio by adjusting the oxygen partial pressure.

Response to Arguments

In the reply filed on July 27 2009, Applicants did not argue the rejection as it pertains 6-13 and 16-18. The arguments were only directed to the rejection as it pertains to claim 1, which is not rejected above.

Claims 1-5 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bujard et al. in view of Deluca et al. (WO 0216505).

Applicant Claims

The instant application claims a cosmetic and personal care preparation comprising (a) from 0.0001 to 90% by weight of a gloss pigment comprising (a1) a core

Art Unit: 1616

consisting of a substantially transparent or metallically reflecting material and (a2) at least one coating consisting of one or more silicon oxide, the molar ratio of oxygen to silicon being on average from 0.03 to 0.95 and (b) from 10 to 99.9999% of a cosmetically suitable carrier material based on the total weight of the cosmetic preparation or formulation wherein said formulation or preparation is selected from the group consisting of lipsticks, blushers, foundations, nail varnishes and hair shampoos.

**Determination of the Scope and Content of the Prior Art
(MPEP §2141.01)**

The teachings of Bujard et al. are set forth above. Specifically, Bujard et al. teach a colored luster pigments comprising a core consisting of a substantially transparent or metallic reflecting material and at least one coating consisting essentially of one of more silicon oxides having a molar ratio of oxygen to silicon being from 0.25 to 0.95 (col. 2, line 62 to col. 3, line 2). Column 3, lines 31-46 teach examples of the core material such as Si, Ti and Mica. Column 4, lines 8-9 teach that the pigments can further comprise an additional coating which is different from the first; lines 26-29 teach examples of the metal oxides and mixtures thereof that can be employed in the second coating; finally line 34-35 teach that the arrangement of coatings relative to the core may be in any order. Column 8, lines 28-30 teach that high molecular weight organic materials can be used with the pigments. When utilized they are used in amount from 0.1 to 30% by weight (column 9, lines 23-31). It is taught that the ratio of silicon to oxygen can be precisely controlled by adjusting the oxygen partial pressure (column 6, lines 57-65). The colorations obtained have excellent properties such as high brightness and excellent fastness properties (column 10, lines 29-34).

Art Unit: 1616

**Ascertainment of the Difference Between Scope the Prior Art and the Claims
(MPEP §2141.012)**

Bujard et al. do not teach utilizing the pigments in cosmetic or personal care composition. However, this deficiency is cured Deluca et al.

Deluca et al. is directed to colored lustrous pigments. The pigments are metal oxide coated mica (page 3, lines 15-18). The metal oxide coatings include titanium dioxide, zirconium dioxide and iron oxide (page 4, lines 4-6). Depending on the thickness of the coating, the pigments can exhibit interferences or reflection colors of blue, green, yellow, red, etc. (column 4, lines 14-16). Exemplified particles are titanium dioxide coated mica. The pigments are utilized in cosmetic products such as lipsticks, eye shadow, cream eye shadow and lotions (page 8). Exemplified amounts of colorants utilized in cosmetics include 15, 45, 20, and 5%.

***Finding of Prima Facie Obviousness Rationale and Motivation
(MPEP §2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of Bujard et al. and Deluca et al. and utilize the colored luster pigments of Bujard et al. in a cosmetic formulation. One of ordinary skill in the art would have been motivated to utilize these pigments in cosmetic formulations as Deluca et al. teach similar colored luster pigments are known to be utilized in cosmetic formulations for adding color. Since Bujard et al. teach adding the pigments to products for adding color, it would have been obvious to one of ordinary skill in the art to add the pigments to cosmetic formulations for adding color to the composition. One of ordinary skill in the art would have a reasonable expectation of

Art Unit: 1616

success as Deluca et al. teach metal oxide coated pigments wherein the core is mica and Bujard et al. teach metal oxide coated pigments wherein the core can be mica. Therefore, the substantially similar colored luster pigments of Bujard et al. would be expected to color cosmetic formulations based on the teachings of Deluca et al.

Absent any evidence to the contrary, and based upon the teachings of the prior art, there would have been a reasonable expectation of success in practicing the instantly claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ABIGAIL FISHER whose telephone number is (571)270-3502. The examiner can normally be reached on M-Th 9am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Abigail Fisher
Examiner
Art Unit 1616

AF

/Mina Haghighatian/
Primary Examiner, Art Unit 1616